

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentee: Jay S. Walker, et al.
Patent No.: 7,892,090
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Appl. No.: 10/729,439
Conf. No.: 2150
Filed: December 5, 2003
Title: GAMING DEVICE AND METHOD OF OPERATION THEREOF
Art Unit: 3714
Examiner: Mark Alan Sager
Docket No.: 3718582-00305

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(d)**

Sir:

Patentee hereby petitions for reconsideration of the Patent Term Adjustment accorded the above-referenced application at the time of issuance. The Issue Notification and Determination of Patent Term Adjustment under 35 U.S.C. 154(b), mailed on February 2, 2011, states that the Total PTA is 859 days. That is, Non-Overlapping USPTO Delay days of 1239, APPL Delay days of 155, and a PTO Manual Adjustment of -225 days. The APPL Delay days of 155 appear to be understated, the Non-Overlapping USPTO Delay days of 1239 appear to be overstated, and the PTO Manual Adjustment of -225 days does not appear to remedy these errors, resulting in the Total PTA being shorter than appropriate on the issue date of February 22, 2011.

Patentee respectfully requests a review of the prosecution file history, with attention to the following entries: (1) the March 17, 2009 entry of Mail Final Rejection (PTOL – 326); (2) the September 25, 2009 entry of Aband. For Failure to Respond to O.A.; (3) the September 28, 2009 entry of Mail Abandonment for Failure to Respond to

Office Action; (4) the October 23, 2009 entries of Petition Entered and Request for Continued Examination (RCE); (5) the December 31, 2009 entry of Petition to Revive Application – Granted; (6) the January 4, 2010 entry of Mail-Petition to Revive Application – Granted; (7) and the March 19, 2010 entry of Mail Non-Final Rejection; (8) the August 25, 2010 entry of Petition Entered; and (9) the January 4, 2011 entry of Adjustment of PTA Calculation by PTO.

STATEMENT OF FACTS

1. The Abandonment and Subsequent Revival of the Present Application

The USPTO mailed a Final Office Action on March 17, 2009. The USPTO did not receive a response to the Final Office Action or a request for an extension of time. As a result, the application became abandoned on June 18, 2009. On October 23, 2009, Patentee filed a Petition to Revive under 37 C.F.R. § 1.137(b) in conjunction with a Request for Continued Examination. On January 4, 2010, the USPTO mailed a decision granting Patentee's Petition to Revive. On March 19, 2010, the USPTO mailed a Non-Final Office Action.

2. PTA Calculations Associated With the Abandonment and Subsequent Revival of the Present Application

Under 37 C.F.R. § 1.704(c)(3), the proper reduction in patent term adjustment stemming from abandonment and subsequent revival of an application is the number of days "beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of: (i) [t]he date of mailing of the decision reviving the application or accepting late payment of the issue fee; or (ii) [t]he date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed."

Here, the date of mailing of the decision reviving the application (January 4, 2010) was earlier than the date four months after the date Patentee's Petition to Revive was filed (i.e., February 24, 2010). Therefore, the proper reduction in PTA stemming from the abandonment and subsequent revival of the present application is the number of days beginning on the date of abandonment (June 18, 2009) and ending on the date

of mailing of the decision granting Patentee's Petition to Revive (January 4, 2010). Accordingly, Patentee should have been assessed 201 APPL Delay days associated with the abandonment and subsequent revival of the present application.

Under 37 C.F.R. § 1.703(a)(2), Patentee is entitled to PTA of "[t]he number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of a mailing of . . . an action under 35 U.S.C. 132."

Here, Patentee filed an RCE on October 23, 2009, in response to the Final Office Action mailed on March 17, 2009. Subsequently, the USPTO mailed a Non-Final Office Action on March 19, 2010. The USPTO calculated a Non-Overlapping USPTO Delay of 24 days associated with this Non-Final Office Action. However, the present application was abandoned at the time the RCE was filed. Since the Non-Final Office Action was mailed within four months of the application's revival, Patentee is not entitled to PTA associated with this Non-Final Office Action.

3. The PTA Determination at Allowance

In the USPTO's PTA Determination at Allowance, the USPTO did not calculate any APPL Delay days associated with the abandonment and subsequent revival of the present application. In other words, the USPTO did not assess Patentee with the 201 APPL Delay days discussed above. On August 25, 2010, Patentee filed a Request for Reconsideration of Patent Term Adjustment that indicated this omission.

In its decision on the Request for Reconsideration of Patent Term Adjustment mailed on January 11, 2011, the USPTO correctly determined: (1) that Patentee should be assessed 201 APPL Delay days associated with the abandonment and subsequent revival of the application, and (2) that the USPTO's PTA Determination at Allowance erroneously included 24 Non-Overlapping USPTO Delay days associated with Non-Final Office Action mailed on March 19, 2010.

In other words, the USPTO determined that APPL Delay days were understated by 201 days at allowance, and that Non-Overlapping USPTO Delay days were overstated by 24 days at allowance. Collectively, the USPTO determined that the Total PTA at allowance was overstated by 225 days.

4. The PTO Manual Adjustment Used in the USPTO's PTA Determination at Issuance.

In the USPTO's PTA Determination at Issuance, the USPTO calculated 1239 Non-Overlapping USPTO Delay days, which include 24 Non-Overlapping USPTO Delay days associated with Non-Final Office Action mailed on March 19, 2010. In other words, the USPTO did not correct its previous overstatement of 24 Non-Overlapping USPTO Delay days in its PTA Determination at Allowance.

In its PTA Determination at Issuance, the USPTO also calculated 155 APPL Delay days, which include 94 APPL Delay days associated with the abandonment and subsequent revival of the present application. In other words, the USPTO did not correctly calculate the 201 APPL Delay days associated with the abandonment and subsequent revival of the application.

Also in its PTA Determination at Issuance, and presumably to correct the above-explained errors in the PTA calculations at allowance, the USPTO included a PTO Manual Adjustment of -225 days. This number of -225 days corresponds to the number of days that Total PTA was overstated at allowance.

This PTO Manual Adjustment does not, however, remedy the errors in the PTA calculations at allowance. Specifically, the PTO Manual Adjustment does not take into account the fact that the PTA Determination at Issuance calculated 94 APPL Delay days associated with the abandonment and subsequent revival of the present application, while the PTA Determination at Allowance calculated no APPL Delay days associated with the abandonment and subsequent revival of the application. Therefore, assuming, arguendo, that the USPTO's PTA calculations at issuance are not modified, the PTO Manual Adjustment is overstated by 94 days.

5. Terminal Disclaimers

This patent is subject to Terminal Disclaimers to Patent Nos. 6,190,256 and 6,682,844. More specifically, this patent is a continuation of the '844 Patent, which is a continuation of the '256 Patent. The '256 Patent was filed on June 22, 1998, and has no PTA days. Thus, the Terminal Disclaimer over the '256 Patent will limit the term of instant patent to include 0 days of its Total PTA Days, as it will expire on June 22, 2018.

6. Circumstances Constituting a Failure to Engage in Reasonable Efforts to Conclude Processing or Examination

Patentee respectfully submits that there do not appear to be any additional circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of this application other than the one discussed above and the others calculated by the USPTO.

REMARKS

In consideration of the events described above, Patentee believes the Total PTA calculation of 859 days is understated as of the issuance date. Patentee respectfully requests reconsideration of the Patent Term Adjustment. To correct the above-explained errors, the USPTO may either (1) remove the PTO Manual Adjustment and correct the PTA calculations at issuance, or (2) not modify the PTA calculations at issuance and remedy the error in the PTO Manual Adjustment.

1. Correction of Non-Overlapping USPTO Delay Days and APPL Delay Days and Removal of PTO Manual Adjustment

- 1) Non-Overlapping USPTO Delay days should be decreased from 1239 to 1215 to reflect a removal of the 24 days erroneously associated with the Non-Final Office Action mailed March 19, 2010;
- 2) APPL Delay days should be increased from 155 to 262 to reflect an increase of 107 days associated with the abandonment and subsequent revival of the present application;
- 3) PTO Manual Adjustments should be decreased from -225 to 0 to reflect the correct calculations of Non-Overlapping USPTO Delay days and APPL Delay days; and
- 4) Total PTA days should be increased from 859 days to 953 days (1215 Non-Overlapping USPTO Delay days–262 APPL Delay days).

2. Alternatively, Correction of the PTO Manual Adjustment

- 1) PTO Manual Adjustments should be decreased from -225 to -131; and

- 2) Total PTA days should be increased from 859 days to 953 days (1239 Non-Overlapping USPTO Delay days–131 PTO Manual Adjustment–155 APPL Delay days).


Pursuant to 37 CFR § 1.18(e), the fee of \$200 is submitted herewith. To the extent that any additional fees are due for this Petition, the Commissioner is hereby authorized to charge them to Patentee's undersigned attorney's Deposit Account, 02-1818.

Thank you for your consideration.

Respectfully submitted,

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